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FINNEGAN HENDERSON FARABOW GARRETT & DUNNER 1300 I STREET NW WASHINGTON, DC 20005			EINSMANN, MARGARET V	
			ART UNIT	PAPER NUMBER
			1751	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 102004

Application Number: 09/424,116

Filing Date: January 06, 2000

Appellant(s): LANG ET AL.

MAILED

JAN 28 2004

GROUP 1700

Mark J. Feldstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 13, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Applicant states that for each ground of rejection the claims stand or fall together.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,919,273	Rondeau et al.	7-1999
4,588,410	Konrad et al.	5-1986
4,025,301	Lang	5/1977
6,001,135	Rondeau et al.	12/1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

- A. Claims 26-60 are rejected under 35 U.S.C. 103(a) over Rondeau et al., US 5,919,273. This rejection is set forth in prior Office Action, Paper No. 18.
- B. Claims 26-60 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-43 of US 5,919,273. This rejection is set forth in prior Office Action, Paper No. 18.
- C. Claims 26-36 and 40-60 are rejected under 35 U.S.C. 103(a) over Lang, US 4,025,301 in view of Konrad et al., US 4,588,410. This rejection is set forth in prior Office Action, Paper No. 18.
- D. Claims 37-39 are rejected under 35 U.S.C. 103(a) over Lang in view of Konrad and further in view of Rondeau et al., US 6,001,135. This rejection is set forth in prior Office Action, Paper No. 18.

(11) *Response to Arguments*

Response to arguments regarding rejection A.

Appellant argues that claims 26-60 are not obvious over Rondeau et al because

- (1) a compound does not always render prima facie obvious its isomers
- (2) there is no evidence of a reason or motivation to modify Rondeau '273 dye II-30 as proposed by examiner and (3) objective evidence demonstrates that isomers in the dyeing art are not equivalent. Regarding (1) appellant states that there is no per se rule that all chemical species in all arts will render obvious its

positional isomers. Appellant cites M.P.E.P. 2144.09. The examiner's copy of M.P.E.P. 2144.09 states, "A prima facie case of obviousness may be made when chemical compounds **have very close structural similarities and similar utilities.**" In the instant case, both of these properties exist. The structural similarities are as close as is possible, and the utilities are identical. See Lang of record which shows that the two pyridoneazo isomers, the pyridine dye of Rondeau is known as a cationic hair dye and appellant's claimed dye is known as a cationic hair dye. Rondeau also teaches that the isomer is contained in a hair dye composition. This rejection is not based on one isomer being, for example, a drug and the other a hair dye. Additionally, the section of the MPEP referred to above relates to the obviousness of compounds. The rejected claims are not compound claims. They are composition claims, comprising three ingredients, two of which are identical and the third of which is the isomer. Accordingly, put into the context of a hair dyeing composition, used for the identical purpose, the use of an isomeric cationic hair dye to replace a cationic hair dye in a hair dyeing composition is prima facie obvious. The M.P.E.P. further states, citing *In re Wilder*, 563 F.2d 457, 195 USPQ 426(CCPA 1977) that compounds which are position isomers are generally of sufficiently close structural similarity that there is a **presumed expectation** that such compounds possess similar properties. The fact that there is a presumed expectation that such compounds possess similar properties is the motivation to make the isomeric compound and to then form the dyeing composition as claimed by

replacing the dye of Rondeau with appellant's isomeric dye. Appellant states that there is no evidence that dye II-30 would have suggested any or all of its isomers. See the above reasoning in the selections from M.P.E.P 2144.09.

Appellant states that there is no motivation to choose Dye II-30 since Rondeau does not prefer dye II-30 over the other claimed dyes. The real fact is that dye II-30 is listed as a preferred dye. See col 8 lines 43-48. It is even claimed specifically as part of the composition claimed by Rondeau in claim 19, said composition containing the other two ingredients in appellant's claimed compositions. In footnote 1, appellant quotes part of a sentence from Ex parte Mowry out of context. In context, said quotation is followed by the explanation that claimed cyclohexylstyrene is not *prima facie* obvious over prior art isohexylstyrene. This comparison is not analogous to the instant case because the pyridine isomers in this case are structurally related while said cyclic alkyl in the explanation has a structure which is unrelated to its isoalkyl counterpart. The structures of the isomers in the instant case have the same empirical formula as well as a very close structural formula. In Ex parte Audouset, Appeal No. 2003-0478 at 5 (BdPatApp&Int 2003), in which L'Oreal is assignee, the court cited *Merck & Co v Biocraft Laboratories Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert denied, 493 U.S. 975 (1989) which states, "That the '813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose."

Next appellant calls the examiner's focus on compound II-30 hindsight. On the contrary, compound II-30 is particularly pointed to by Rondeau in the specification at column 12 lines 40-45 and in the composition claimed in claim 19. Appellant then states that said pyridine dye has 10,00 isomers. It is not clear why appellant is moving all of the groups around in coming to his conclusions. However, as stated above, the isomer has the same empirical formula, is a very closely relates isomer, is used for the same purpose, and is used as the third component in a composition comprising the same first two components. Again the **compositions** claimed are *prima facie* obvious over the **compositions** of Rondeau.

Appellant then argues that dye isomers are known to be not equivalent. He uses as evidence para-aminophenol and meta-aminophenol. These two compounds are not cationic direct dyes but are oxidation dyes. (Note appellant's statement on page 16 of the brief, "Direct dyes can generally be **contrasted** with oxidation dyes,...") Oxidation dyes are dye precursors which react on the hair to form dyes in the presence of an oxidation agent. They could be called dye formers. Appellant should read page 265 of Zviak (which he has supplied) in context, as it explains how such uncolored oxidation bases and couplers react on the hair to form dyes. The direct dyes as claimed are dyes which are already colored dye compounds before they are applied to the hair. Accordingly the analysis on page 12 of the brief is not pertinent. What is pertinent is what is contained in the Lang reference of record which teaches that both of the isomeric

pyridine direct dyes function as colored hair dyeing compounds. Appellant states on page 13 that the dyeing properties of the two isomeric pyridine dyes of Lang are substantially different. One would expect related dyes to have unique properties, and to produce different colors. Because there is a demand in the hair dyeing art to match a myriad of different colors, the dye chemist is always looking for new dyes related to those previously known. Accordingly the rejection is maintained.

Response to arguments regarding rejection B

Appellant applies the same arguments to rejection B as were applied to rejection A. Accordingly this office applies the same response. Additionally, appellant urges us to consider the claims of Rondeau. We note claim 1 and claim 19 in particular. The composition of claim 1 containing the dye II-30, which is the position isomer of the dye claimed in the instant application, is clearly claimed in claim 19. Accordingly the rejection is maintained.

Reponse to arguments regarding rejection C.

Appellant first states that there is no motivation to suggest the desirability of the proposed combination of Lang in view of Konrad. Applicant argues that there is no motivation to combine the references. Adequate motivation to combine the references is supplied by Konrad, column 2 (see above) who teaches the substituted m-aminophenol as an improvement over m-aminophenol. The purpose of Konrad's

invention to an improved coupler, that is an improved m-aminophenol, making the substitution *prima facie* obvious.

Appellant argues that there is no objective teaching to combine Konrad's substituted m-aminophenol with the direct dye of Lang in example q. However, Applicant is not adding a component but is replacing the m-aminophenol in example q with the m-aminophenol which has been invented by Konrad as an improvement over m-aminophenol. Appellant argues that Konrad does not teach nor suggest the substitution of the coupler of formula I for m-aminophenol for use in compositions comprising both an oxidation base and a direct dye. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Konrad need not show or teach or suggest the substitution of the coupler of formula 1 for m-aminophenol because Lang is applied for the teaching that meta-aminophenol and appellant's direct dyes are used in combination. Thus all of the dyes are used in compositions for dyeing hair. It is *prima facie* obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. See *In re Kerkhoven*, 205 USPQ 1069, 1072. Applicant next argues that there is no teaching to use Konrad's coupler in a composition comprising all 14 components in example q of Lang. Applicant is directed to his own specification, pages 27 and 28 which reveals that most of the components are part of the "common dye

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support" used with any combination of dyes. They are not reactive components.

Regarding the arguments that Kerkhoven is not applicable, appellant states that the components of the composition polymerize and therefore are reactive components, not static components. The direct dye is not a reactive component, and does not take part in the oxidative polymerization. Accordingly that argument is not applicable. The direct cationic dyes are known additives to oxidation dyeing compositions to provide added glints and shades. They do not react with the bases and couplers. The term "direct dye" means that the dye is already formed and colors the substrate without the need for further reaction. Appellant states, "Given that Lang example q is a complex chemical mixture..." The dye chemist knows that most of the 19 components in the mixture are static components which are commonly used in dyeing compositions; the only reactive components are the oxidation bases and couplers, and they are known to color hair when used in combination with an oxidant. That is predictable. The direct dye will also color the hair directly, not by participating in the polymerization reaction of the oxidation bases and couplers in the presence of an oxidant.

While appellant states that there are no known disadvantages disclosed by Lang for example q, the disadvantages of m-aminophenol as coupler are taught by Konrad who teaches that 2-hydroxy-4-aminobenzenes were developed to replace m-aminophenols because of known disadvantages of m-aminophenols in combination with resorcinol, p-phenylenediamines, 2,5 diaminotoluene and p-aminophenol. Appellant points to the oxidation bases in example q of Lang: paratoluene diamine is a para-phenylenediamine , p-aminophenol, and p-aminophenol sulfate (which is the salt form

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of p-aminophenol.) All three are listed as oxidation bases which show improved properties when combined with the 2-hydroxy-4-aminobenzenes of Konrad. See page 2 lines 24-42 of Konrad. Appellant states that Konrad does not allege that the use of his substituted coupler will provide advantages in a combination dyeing composition. In fact he specifically refers to improvements with the three oxidation bases in composition q, and to the coupler resorcin which is in composition q, as having improvements when m-aminophenol is replaced by Konrad's substituted m-aminophenol.

In footnote 8, appellant argues that oxidation bases can function as direct dyes. Conventional oxidation dyes do not function as direct dyes. They do not color directly. See Zviak of record. Appellant is referring to the specific case of a diaminobenzene compound having a nitro substituent. The diaminobenzene functions as an oxidation dye, that is, it reacts on the hair (polymerizes) to form color. Nitrobenzene compounds are known colored compounds which color directly. The cationic monoazo direct dyes of this application are not structurally related to said diaminobenzene compounds, and accordingly do not react with the oxidation dye precursors in the presence of oxygen. Conventionally known oxidation dye precursors do not contain nitro groups, and are uncolored compounds which do not color directly.

Appellant then argues that each dyeing combination is unique and produces a unique color. The examiner agrees that each dye component alters the overall color of the resultant hair. Appellant states that the effects of additional components in a dye composition cannot be predicted, and quotes a statement from a previous office action out of context. The statement, "It is unclear how these additional dyes effect the overall

results," made in a previous office action does not say that the effects of additional components cannot be predicted. The statement was made in relation to the comparison needed by appellant to overcome a case of *prima facie* obviousness.

Appellant argues that *In re Kerkhoven* is not applicable. In a related appeal, in which the issues are analogous, Ex parte Lang, Appeal No.2003-0465 at 4-5 (BdPatApp&Int 2003) for application 09/424,119 which appellant acknowledges is a related case, the court cited *In re Kerkhoven*, stating that the idea of combining them logically flows from their having been individually taught in the prior art. In that case, the same 3-aminopyridine azo dyes were combined with an oxidation base. Appellant is claiming a mixture. It is well established that the cationic azo dye does not react with the oxidation bases or couplers. For all the above reasons, the rejection must be maintained.

Response to arguments regarding rejection D.

Applicant argues the rejection of claims 37-39 over Lang in view of Konrad further in view of Rondeau et al by stating that since the equivalence involves reactive components, there is no teaching of equivalence. The examiner respectfully disagrees. There is a clear teaching of equivalence, that is, a teaching that one oxidation base can be substituted for another at the place cited above. Appellant bases argument on the absence of equivalency by citing Ex parte Maubru, Appeal No. 2003-0617 at 7-8 (BdPatApp&Int 2003). In that case, appellant argued that in order for compounds to be deemed equivalent, they must be used for the same purpose. One reference used the compounds to dissolve insufficiently soluble compounds while the other used a similar

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compound as a cosmetic additive, not as a solvent. In the instant case, the compounds serve the **exact same function**, that of oxidation bases. Oxidation bases serve the function of forming colored dye compounds by polymerizing on the hair. See Zviak of record. Accordingly, the rejection must be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Margaret Einsmann
Margaret Einsmann
Primary Examiner
Art Unit 1751

January 21, 2004

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Attachments:

Ex parte Audouset, Appeal No.2003-0478 (BdPatApp&Int 2003)

Ex parte Lang, Appeal No.2003-0465 (BdPatApp&Int 2003)

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte MARIE-PASCALE AUDOUSSET

OCT 30 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0478
Application No. 09/433,546

ON BRIEF

Before KIMLIN, PAK, and OWENS, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 27, which are all of the claims pending in the present application.

APPEALED SUBJECT MATTER

According to the appellant (Brief, pages 3 and 4):

For convenience in handling this Appeal, however, the claims will be grouped in one group. Thus, pursuant to 37 C.F.R. [CFR] § 1.192(c)(7), in this Appeal, the rejected claims will stand or fall together.

Appeal No. 2003-0478

Application No. 09/433,546

Therefore, for purposes of this appeal, we select claim 1 from all the claims on appeal and decide the propriety of the examiner's Section 103 rejections based on this claim alone consistent with 37 CFR § 1.192(c)(7)(2001). Claim 1 is reproduced below:

1. A composition for the oxidation dyeing of keratin fibers, comprising:

- an oxidation base comprising at least one pyrazolo(1,5-a)pyrimidine; and
- at least one cationic direct dye,

wherein said composition is essentially free of enzymatic systems capable of bringing about the oxidation of said at least one pyrazolo(1,5-a) pyrimidine.

PRIOR ART REFERENCES

As evidence of obviousness, the examiner relies on the following prior art references:

Tamura et al. (Tamura) 5,015,260 May 14, 1991

Terranova et al. (Terranova)¹ WO 97/49378 Dec. 31, 1997
(Published World Patent Document)

Rondeau et al. (Rondeau)² 2 757 388 A1 Jun. 26, 1998
(Published French Patent Application)

¹ Our reference to Terranova is to its corresponding English translation of record.

² Our reference to Rondeau is to its corresponding English translation of record.

REJECTIONS

The appealed claims stand rejected as follows:

- (1) Claims 1 through 4 and 6 through 27 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Terranova and Rondeau; and
- (2) Claims 1 through 5 and 14 through 27 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Terranova and Tamura.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments and evidence advanced by the examiner and the appellant in support of their respective positions. This review leads us to conclude that the examiner's Section 103 rejections are well founded. Accordingly, we affirm these Section 103 rejections for essentially those reasons set forth in the Answer and below.

The examiner has found (Answer, page 6), and the appellant has acknowledged (Brief, page 7), that Terranova teaches a composition for the oxidative dying of keratin fibers, which comprises at least one pyrazolo-(1, 5-a)-pyrimidine derivative as an oxidation base and at least one direct dye. See also, e.g., Terranova, page 1, lines 1-5 and page 14, lines 12-14. The appellant has not disputed

the examiner's finding that the pyrazolo-(1, 5-a)-pyrimidine derivatives described in Terranova corresponds to the claimed oxidation base comprising at least one pyrazolo(1, 5a)pyrimidine. Compare the Answer in its entirety with the Brief and the Reply Brief in their entirety. Nor has the appellant disputed the examiner's finding that the composition described in Terranova "is essentially free of enzymatic systems capable of bringing about the oxidation of said at least one pyrazolo(1, 5-1)pyrimidine" as required by claim 1. Compare the Answer in its entirety with the Brief and the Reply Brief in their entirety.

The dispositive question is, therefore, whether it would have been obvious to one of ordinary skill in the art to employ at least one cationic direct dye as the direct dye of the composition described in Terranova. On this record, we answer this question in the affirmative.

We, like the examiner, find that Terranova teaches (page 3, lines 18-27 and page 14, lines 12-14) that:

The Applicant has recently discovered, in a completely unexpected and surprising fashion, a new family of pyrazolo-[1,5-a]-pyrimidine derivatives of formula (I) defined hereinafter, in part novel in and of itself, which may be appropriate for use as oxidation dye precursors, but which may also yield dye compositions leading to powerful dyes that are highly resistant to external agents (light, poor weather, washing, hair processing, perspiration, rubbing). Lastly these

compounds prove to be easily synthesized and are chemically stable. They have a good toxicological profile.

The oxidation dye compositions according to the invention may also include at least one coupler and/or at least one direct colorant, in order to alter or highlight the tones.

We find that the direct dye described in Terranova not only embraces the claimed cationic direct dye, one of the four possible subgenera³, but also overlaps significantly with the claimed cationic direct dye in terms of the number of direct dyes covered⁴.

Although Terranova alone may have rendered the claimed subject matter *prima facie* obvious to one of ordinary skill in the art⁵,

³ The four possible subgenera include cationic direct dyes, nonionic direct dyes, anionic direct dyes and amphoteric direct dyes.

⁴ According to pages 8 through 56 of the appellant's specification, the claimed cationic direct dye encompasses millions of direct dyes.

⁵ Compare *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) ("That the '813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purposes."); *In re Schaumann*, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978) ("[T]he disclosure of a chemical genus...constitute[s] a description of a specific compound" within the meaning of 35 U.S.C. § 102 if the specific compound is one of the "very limited number of compounds" covered by the generic disclosure.); *In re Susi*, 440 F.2d 442, 446, 169 USPQ 423, 426 (CCPA 1962) ("[T]he combination, (continued...)

the examiner further relies on the disclosure of either Rondeau or Tamura since Terranova does not expressly teach its direct dye as a cationic direct dye.

We find that both Rondeau and Tamura, like Terranova, teach a composition for the oxidative dyeing of keratin fibers, comprising an oxidative base, at least one direct dye and at least one coupler, with Rondeau's improvement residing in employing at least one particular cationic direct dye as its direct dye and Tamura's improvement residing in employing at least one particular coupler as its coupler. See Tamura, column 1, lines 23-62 and column 7, lines 15-51 and Rondeau, See page 2, lines 1-8, page 2, lines 1-3, page 4, lines 1-8, page 39, lines 5-15, and page 47, lines 1-21. We find that Rondeau teaches preference for its cationic direct dyes over other conventional direct dyes (direct colorant) in its oxidation base composition to obtain "colorations ... presenting good properties such as tenacity..." even though it, like Terranova, recognizes that it was known in the art to use direct dyes (direct colorants) in general, together with a coupler and an oxidation base, to improve colorations. See page 3.

⁵(...continued)
for the same purpose, of one additive explicitly disclosed in the prior art and another suggested by the prior art would be at least *prima facie* obvious.").

On the other hand, we find that Tamura teaches that the types of particular direct dyes employed are dependent on the types of color desired. See column 7, lines 15-51. In other words, we determine that one of ordinary skill in the art would have recognized from this teaching that the direct dyes, inclusive of cationic direct dyes, which control colorations of hair (keratin fibers), are result effective variables.

It follows that one of ordinary skill in the art would have been led to employ at least one cationic direct dye as the direct dye of the composition described in Terranova, motivated by a reasonable expectation of successfully forming an effective oxidative dyeing composition (a compositing having, *inter alia*, the best oxidation base and best cationic direct dye taught by Terranova and Rondeau, respectively)⁶ and/or motivated by a reasonable expectation of successfully adding a desired color to given keratin fibers as taught by Tamura⁷. Accordingly, we determined that the examiner has established a *prima facie* case of

⁶ Compare *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *Susi*, 440 F.2d at 445-46, 169 USPQ at 425-26.

⁷ See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.").

obviousness regarding the claimed subject matter within the meaning of 35 U.S.C. § 103⁸.

As a rebuttal to the *prima facie* case established by the examiner, the appellant appears to argue (Brief, page 3) that:

The present invention features the surprising and unexpected discovery that combining at least one pyrazolo[1,5-a]pyrimidine as the oxidation base with at least one cationic direct dye can result in intense colorations with improved properties of resisting various attacking forces, such as at least one of shampoo, light, bad weather, permanent-waving, perspiration, rubbing, and the like. Specification, p.2, lines 15-22.

However, the appellant has not referred to any factual evidence to buttress his argument in his Brief and Reply Brief. See *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984) (A showing of unexpected results is a factual question); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("Mere argument or conclusory statements in the specification does not suffice."). Nor has the appellant made any comparison between the claimed subject matter and the closest prior art, i.e., *Terranova*. See *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *De Blauwe*, 736 F.2d at 705, 222

⁸ Contrary to the appellant's arguments in his Brief and Reply Brief, evidence of suggestion or motivation as required by *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) is present in this case as indicated *supra*.

USPQ at 196. It follows that the appellant has not carried his burden of establishing unexpected results. See *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973).

In view of the foregoing, we determine that the evidence of obviousness, on balance, outweighs the evidence of nonobviousness proffered by the appellant. Hence, we conclude that the applied prior art references as a whole would have rendered the claimed subject matter obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's decision rejecting the appealed claims under 35 U.S.C. § 103.

Appeal No. 2003-0478
Application No. 09/433,546

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Edward C. Kimlin

EDWARD C. KIMLIN)
Administrative Patent Judge)

Chung K. Pak

CHUNG K. PAK)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Terry J. Owens

TERRY J. OWENS)
Administrative Patent Judge)

CKP:lp

Appeal No. 2003-0478

Application No. 09/433,546

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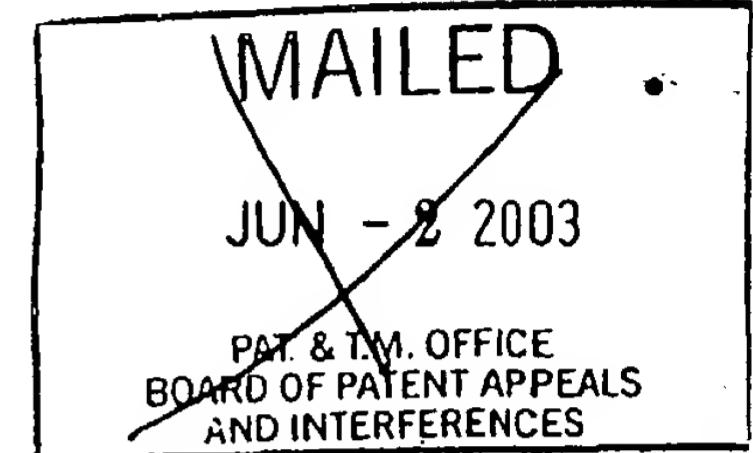
The opinion in support of the decision being entered today was
not written for publication and is not binding precedent of the
Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARD LANG, JEAN COTTERET,
and MIREILLE MAUBRU



Re mailed 6-19-03

Appeal No. 2003-0465
Application No. 09/424,119

HEARD: May 20, 2003

Before GARRIS, PAK, and DELMENDO Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 18-42 which are all of the claims remaining in the application.

The subject matter on appeal relates to a composition, as well as to a kit, for the oxidation dyeing of keratin fibers comprising at least one heterocyclic oxidation base and at least

one 3-aminopyridine derivative as a direct dye chosen from compounds having a particular formula. This appealed subject matter is adequately illustrated by independent claim 18, a copy of which taken from the appellants' brief is appended to this decision.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Lang	4,025,301	May 24, 1977
Clausen et al. (Clausen)	5,061,289	Oct. 29, 1991

All of the claims on appeal stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Clausen.¹ On page 4 of the answer, the examiner expresses his obviousness conclusion as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the p-aminophenol oxidation bases in the compositions and processes of Lang (which use direct dyes of formula (1) as claimed), resulting in dyeing compositions and processes as claimed, because Lang does not require any specific oxidation dyes for use in the patentee's compositions, and Clausen teaches that the claimed diaminopyrazoles

¹ Notwithstanding the contrary indication on page 5 of the brief, the appealed claims will stand or fall together for the reasons explained by the examiner on page 2 of the answer which reasons have not been contested by the appellants in their brief filed November 25, 2002 in reply to the answer. Accordingly, in assessing the merits of the rejection before us, we will focus on independent claim 18 as representative of the here rejected claims. See 37 CFR § 1.192(c)(7)(8)(2001).

have various improvements over conventionally used p-aminophenols such as improved physiological properties and the ability to obtain brilliant red shades with a great depth of color. Clausen also teaches that the diaminopyrazoles are compatible with conventional direct dyes, further motivating those skilled in the art to add such dyes to Lang's compositions.

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning the above noted rejection, we refer to the brief and reply brief and to the answer for a complete exposition thereof.

OPINION

We will sustain this rejection for the reasons well stated in the answer and for the reasons set forth below.

Notwithstanding a complete consideration of the arguments and evidence advanced by the appellants in their brief and reply brief, we are convinced that the reference evidence adduced by the examiner establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. That is, a prima facie case exists for concluding that it would have been obvious for one with ordinary skill in the art to combine the compositions of Lang and Clausen in the manner and for the reasons thoroughly discussed by the examiner in order to form a composition corresponding to that defined by appealed independent claim 18. As explained by the predecessor of our reviewing court, it is

prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, as here, in order to form a third composition which is to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. Id.

It is the appellants' position that the applied prior art would not have motivated an artisan to combine Lang and Clausen in the manner proposed by the examiner whereby the para-aminophenol oxidation base of Lang's compositions (e.g., the composition of Example q in column 22) is at least partially replaced with a diaminopyrazole oxidation base taught by Clausen. We agree with the examiner, however, that Clausen teaches a number of advantages with respect to his diaminopyrazole oxidation bases, any single one of which would have motivated an artisan to effect the proposed replacement. These advantages range from avoiding the possibility of para-aminophenol (i.e., 4-aminophenol) not being physiologically tolerated (e.g., see lines 43-46 in column 1 of Clausen)² to obtaining the hair coloring

² According to argument advanced in the reply brief, "Clausen's passing statement about the physiologically tolerability of 4-aminophenol is not supported by any data or

benefits of Clausen's diaminopyrazole oxidation bases (e.g., see lines 50-68 in column 4 and lines 1-10 in column 5).

It is also the appellants' position that the applied references would not have provided the artisan with a reasonable expectation that the examiner's proposed combination would have been successful. In support of this position, the appellants emphasize the unpredictability which attends this art. Like the examiner, we recognize this unpredictability but, unlike the appellants, do not consider it incompatible with a reasonable expectation of success. Indeed, if persuasive, the appellants' position on this matter would necessarily raise the issue of whether the broadly defined composition of appealed independent

other evidence from which one skilled in the art could conclude the existence or degree of the alleged problem" (reply brief, pages 7-8), and, therefore, "[a]bsent such data or evidence, Applicants submit that there is insufficient motivation for one skilled in the art to rely on Clausen's passing statement" (reply brief, page 8). This argument lacks discernible merit. On the record before us, no basis exists for doubting the aforementioned disclosure-of-Clausen-who-may-be-properly-regarded-as-a-person having knowledge and skill in this art. On the other hand, the validity of the argument under consideration is questionable simply because the attorney who made it can not be properly regarded as a person of knowledge and skill in this art. Compare In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (mere lawyer's arguments unsupported by factual evidence are insufficient to establish unexpected results).

claim 18 is enabled by the relatively narrow range of compositions exemplified in their specification disclosure.³

With further regard to the issues of motivation and reasonable expectation of success, the appellants concede that Clausen expressly teaches in the paragraph bridging columns 2 and 3 the use of his diaminopyrazole oxidation bases in combination with conventional direct-dyeing dyestuffs but argue that the specific examples of such dyestuffs listed in this paragraph define a class of direct dyes which does not include the direct dyes of Lang. This argument is not well taken. It is significant that the specific dyes listed in this paragraph are characterized by Clausen as examples of conventional direct-dyeing dyestuffs for use in combination with his diaminopyrazole oxidation bases. This fact would have suggested to an artisan that the types of dyes specifically listed in Clausen's paragraph are merely exemplary, rather than exhaustive as the appellants would have us believe, of the dye types which may be used in

³ It is here appropriate to stress that we see no basis for considering the unpredictable nature of this art to support a determination that an artisan would not be able to practice the here claimed invention just as we see no basis for considering the unpredictable nature of this art to support a determination that an artisan would have no reasonable expectation of success concerning the examiner's proposed combination of Lang and Clausen.

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combination with the diaminopyrazole oxidation bases. For this reason, we share the examiner's position that the artisan would have considered patentee's disclosure of conventional direct-dyeing dyestuffs as suggesting direct dyes which are conventionally used in combination with oxidation bases such as the direct dyes of Lang.

As indicated earlier, we have fully considered the arguments and evidence advanced in the brief and reply brief including, for example, such arguments as the appellants' contention that the applied references actually teach away from the combination proposed by the examiner and their contention that the examiner's proposed combination is the result of improper picking and choosing certain reference teachings while ignoring others. We discern no convincing merit in such argument or evidence for the reasons adequately expressed in the answer.

Under the circumstances set forth above and in the answer, it is our determination that the applied references evince a prima facie case of obviousness which the appellants have not successfully rebutted with argument or evidence of nonobviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It follows that we will sustain the

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examiner's section 103 rejection of claims 18-42 as being unpatentable over Lang in view of Clausen.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris
Bradley R. Garris)
Administrative Patent Judge)

Chung K. Pak
Chung K. Pak) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

Romulo H. Delmendo
Romulo H. Delmendo)
Administrative Patent Judge)

BRG:tdl

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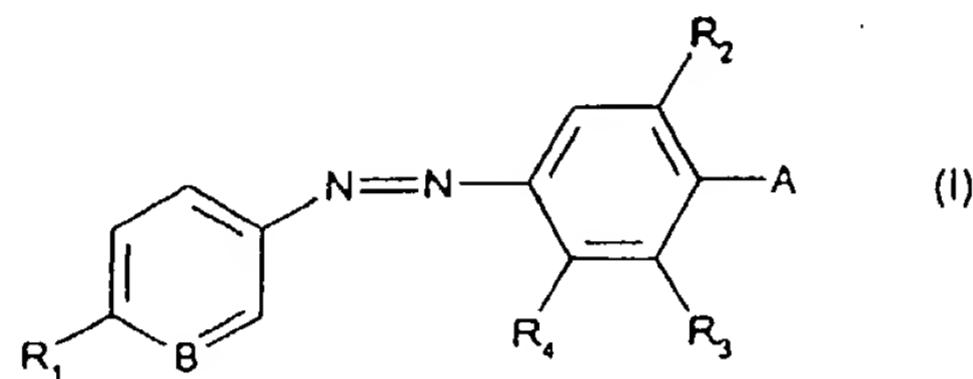
Application No. 09/424,119

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APPENDIX

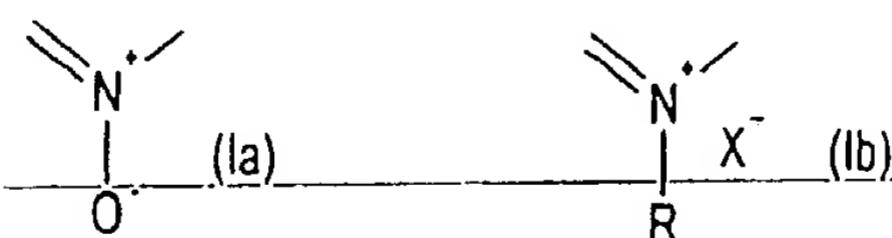
18. A composition for the oxidation dyeing of keratin fibers, comprising:

- a) at least one heterocyclic oxidation base, and
- b) as a direct dye, at least one 3-aminopyridine derivative chosen from the compounds of formula (I):



in which:

- B is chosen from formula (1a) or (1b):



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- R is a C₁-C₄ alkyl radical;
- R₁ is chosen from a hydrogen atom, a halogen atom, a C₁-C₄ alkyl radical, and a C₁-C₄ alkoxy radical;
- R₂ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical and a C₁-C₄ alkoxy radical;
- R₄ is chosen from a hydrogen atom, a halogen atom, a C₁-C₄ alkyl radical, a nitro radical, an amino radical and a (C₁-C₄)acylamino radical;
- R₃ is a hydrogen atom, or R₄ and R₃ together form a 6-membered unsaturated ring bearing a hydroxyl substituent chelated with one of the nitrogen atoms of the azo double bond;
- A is a residue -NR₅R₆ in which R₅ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical, a C₁-C₄ monohydroxyalkyl radical and a C₂-C₄ polyhydroxyalkyl radical; and R₆ is chosen from a hydrogen atom, a C₁-C₄ alkyl radical, a C₁-C₄ monohydroxyalkyl radical, a C₂-C₄ polyhydroxyalkyl radical, a phenyl ring and a -CH₂-SO₃Na radical; and
- X is chosen from a monovalent anion and a divalent anion.